

**IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE**

**Patent Application**

<b>Applicant:</b>	Goode et al.	<b>Filed:</b>	10/20/2003
<b>Attorney Docket No.:</b>	SEDN/132DIV1	<b>Serial No.:</b>	10/689,005
<b>Examiner:</b>	Thomas, Jason M	<b>Group Art Unit:</b>	2423
<b>Confirmation #:</b>	4102		

**TITLE:** METHOD AND APPARATUS FOR PROVIDING DYNAMIC  
PRICING SERVICES FOR AN INTERACTIVE INFORMATION  
DISTRIBUTION SYSTEM

**MAIL STOP APPEAL BRIEF-PATENTS  
COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450**

**SIR:**

**REPLY BRIEF**

Appellants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's Answer, dated April 12, 2010, in the Appeal of the above-identified application.

The Commissioner is authorized to charge any fees due, including extension of time and excess claim fees, to counsel's Deposit Account No. 50-4802/**SEDN/132DIV1**.

## **REMARKS**

Appellants' response to the Examiner's Answer is provided herein below.

### **Section 10 (Response to Arguments)**

In Section 10 (Response to Arguments) of the Examiner's Answer, the Examiner provides answers to the arguments made by the Appellants in the Appeal Brief filed for the above-identified application. The Examiner's answers to Appellants' arguments are addressed below (where sub-sections identify the portions of the Examiner's Answer to which the Appellants are responding).

A. On page 22 of the Response to Arguments section, the Examiner argues:

"The appellant cites column 3, lines 37-51 of Brown suggesting that because the video distribution system has some upper limit on its available bandwidth (see [col. 1, ll. 41-54]), that Brown is not sure about the results, of providing video-on-demand for a near-video-on-demand system. To the contrary, Brown is sure about the results and has designated this system with the intentioned goal of providing video-on-demand when it is available rather than limiting subscribers to near-video-on-demand when more resources are available (see [col. 2, ll. 37-45]). For these reasons combining the features of Brown with that of Knudson would "[enable a subscriber to access any on-demand program within a subscribed programming package on an on-demand basis by allowing the subscriber to interface with one or more programming menus]. ""

1. *The Examiner's proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose.*

The Examiner seems to believe there was an apparent reason to combine Knudson and Brown to produce the claimed subject matter. As shown above, The Examiner asserts that combining the features of Brown with that of Knudson would "[enable a subscriber to access any on-demand program within a subscribed programming package on an on-demand basis by allowing the subscriber to interface with one or more programming menus]. " However "[t]he mere fact references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. See MPEP §2143.01(III). Per MPEP §2143.01(V), "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There are at least two major hurdles to overcome in combining Brown with Knudson.

First, Brown does emphasize system's resources as a condition precedent to providing video-on-demand. Brown states:

At the time of the offer of the NVID presentation, or during the NVID presentation, the viewing node might request a video-on-demand (VOD) version of the interactive application. If such a request is made, and if the system's resources would not be constrained by the transmission of the video-on-demand presentation of the interactive application, then this embodiment transmits the video-on-demand version of the interactive application to the viewing node. On the other hand, if the system's resources would be constrained by the transmission of the VOD version, one embodiment of the invention's interactive system again directs the requesting viewer to view a near-video-on-demand version of the particular application." col. 2:55-67

As can be seen, Brown does recognize the constraint placed on the resources when transmitting VOD. Therefore, when combining Brown with Knudson special consideration must be given to Knudson's limitations (e.g., system resources). Knudson does not suggest the desirability to implement VOD or even near video-on-demand. For example, Knudson discloses:

"It is therefore an object of the present invention to provide an interactive television program guide that supplies information on pay program packages and facilitates the ordering of such programs."

Knudson is very much limited to an interactive television program guides that are typically implemented on set-top boxes. (See Knudson, col. 1, line 18-19). Knudson does not even mention VOD or even near video-on-demand. Consequently, at the very least combining Brown and Knudson is unpredictable, yielding no degree of predictability. There is not an iota of certainty or predictability in such combination. Knudson limits itself to television program guides typically implemented on set-top boxes (limited resources) whereas Brown addresses interactive communication system. (See Abstract).

For the reasons discussed above, the combination of Brown and Knudson would not include all of the elements of the claimed embodiments (including "enabling a subscriber to access any on-demand program within a subscribed programming package on an on-demand basis by allowing the subscriber to interface with one or more menu

applets”). In addition, a corollary of the above is that assuming *arguendo* that a combination of Brown and Knudson somehow can be made, such a combination would render the prior art being modified unsatisfactory for its intended purpose.

Indeed, combining the Brown and Knudson arrangements would result in an inoperable arrangement. Brown’s interactive communication system could not communicate with Knudson set-top boxes without modifications. Accordingly, claim 1 is patentable under 35 U.S.C. §103(a) over Brown in view of Knudson.

B. On page 26 of the Response to Arguments section, the Examiner argues:

“The Examiner would also like to point out that given the broadest reasonable interpretation of “on-demand” it would be within reason to interpret NVOD as providing an on-demand service as claimed, however the examiner included Brown to demonstrate that “instant” “on demand” delivery would be an obvious compliment [sic] to such a system, to one of ordinary skill in the art.”

As articulated above, “if the system’s resources would be constrained by the transmission of the VOD version, one embodiment of the invention’s interactive system again directs the requesting viewer to view a near-video-on-demand version of the particular application.” Hence, video-on-demand is not equivalent to near-video-on-demand to justify interchanging the two as the Examiner did. There is a clear distinction between the two. Therefore, it is incorrect for the Examiner to claim that “it would be within reason to interpret NVOD as providing an on-demand service as claimed.” Ironically, it is the same Examiner who earlier asserted that:

“Brown is sure about the results and has designated this system with the intentioned goal of providing video-on-demand when it is available rather than limiting subscribers to near-video-on-demand when more resources are available”

Further, during patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” >The Federal Circuit’s *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the “broadest reasonable interpretation” standard:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

The broadest reasonable interpretation standard is applied in light of the specification not in a fashion devoid of any framework or reference.

C. On page 29 of the Response to Arguments section, the Examiner again invokes the broadest reasonable interpretation in total disregard of the disclosure of Appellants' specification:

"Likewise the broadest reasonable interpretation in light of the specification of a graphical user interface is a visual computer environment that represents options with graphical images such as icons, menus and dialog boxes on a screen which a user can select."

Appellants respectfully bring to the Examiner's attention that According to MPEP §2111.01(IV):

"Where an explicit definition is provided by the Applicant for a term, that definition will control interpretation of the term as it is used in the claim."

The Specification provides:

"The invention is implemented as one or more interrelated "applets" which, when taken together form the interactive graphical user interface that facilitates the SOD service of the present invention." See Specification, p. 13:21-25.

But the Examiner ignored those teachings of the specification. The specification provides a clear context for persons skilled in the art to understand the term "graphical user interface" as comprising one or more interrelated "applets" which, when taken together form the interactive graphical user interface that facilitates the SOD service of the claimed embodiments. It is entirely appropriate when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims. Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but *in the*

*context of the specification.*” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*). Indeed, the *Phillips* Court stressed that “the specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.” *Id.* at 1315 (quotation omitted).

D. On page 31 of the Response to Arguments section, the Examiner argues:  
“While the examiner is unable to determine which limitation(s) the appellant is referring to as not having been addressed, as the appellant has not specifically indicated what is lacking.”

Claim 7 is reproduced below as reference.

7. (Previously Presented) In an interactive information distribution system containing service provider equipment and subscriber equipment that is interconnected by a communications network, a method of providing a subscription-on-demand service for an interactive information distribution system comprising the steps of:

- sending from said service provider equipment to said subscriber equipment a first menu applet;

- decoding and executing said first menu applet within said subscriber equipment to display a first interactive graphical user interface;

- selecting, through manipulation of the first interactive graphical user interface, a subscription option comprising a hierarchical structure, which may be multi-tiered or grouped;

- sending a selection signal indicative of said selected subscription option from said subscriber equipment to said service provider equipment;

- determining, within said service provider equipment, if the subscriber is a current subscriber to said service identified by said selection signal;

- if the subscriber is said current subscriber, sending a second menu applet from said service provider equipment to said subscriber equipment;

- decoding and executing said second menu applet within said current subscriber equipment to display a second interactive user interface through which the subscriber can select a subscription program for viewing;

if said subscriber is not said current subscriber, sending a third menu applet from said service provider equipment to said subscriber equipment; and

decoding and executing said third menu applet within said subscriber equipment to display a third interactive user interface through which the subscriber can become a subscriber to the selected service.

On page 6 of the Final Office Action, the Examiner provided citations for the preamble. Then the Examiner stated:

“While Knudson teaches providing users with graphical user interfaces (GUI) to receive user selections and then respond accordingly by use of visual displays to provide information about selectable programs which are free and can be tuned for viewing, in addition to providing additional menus in response to the selections made by users which include options to subscribe to subscription content having hierarchical structures (see [abstract], [fig. 2]; see also [fig. 6, items 88 and 96]; see also [col. 1, ll. 55-65], [col. 6, ll. 22-41] where the ability to create a subset by selecting individual teams from a plurality of leagues and teams to create an “a la carte” package, as per the example, reads on dynamically defining a subset which; see also where such a organization of leagues and teams is representative of a hierarchical structure in that sports teams are a subset of individual leagues, which are also a subset of sports programs (i.e. football, baseball, soccer, volleyball, etc.).”

First, the Examiner should map all claim limitations to the pertinent sections of the prior art reference or provide an explanation. The failure to do so deprives Appellant of the opportunity to ascertain the veracity of the Examiner’s claim construction to thereby traverse the rejection.

Second, the Examiner failed to identify the passages where the prior art discloses the limitations claimed. This posture does not adhere to the guidelines set forth in the MPEP and 37 CFR §1.104. Specifically, 37 CFR §1.104(c)(2) provides:

“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”

### CONCLUSION

Appellants submit that all of the claims presently in the application are allowable.

For the reasons advanced in Appellants Appeal Brief, Appellants respectfully urge that the rejection of claims 1-18 is improper. Reversal of the rejection of the Final Office Action is respectfully requested.

Respectfully submitted,

Dated:

5/5/10



Eamon J. Wall  
Registration No. 39,414  
Wall & Tong, L.L.P.  
595 Shrewsbury Ave.  
Shrewsbury, NJ 07702  
Telephone: (732) 842-8110 x120  
Facsimile: (732) 842-8388  
Attorney for Appellant(s)